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In re Application of SIM et al :
U.S. Application No.: 09/763,338 :
Int. Application No.: PCT/AU00/00937 :
Int. Filing Date: 07 August 2000 :
Priority Date: 06 August 1999 :
Attorney Docket No.: 4670/1 :
For: NETWORK RESOURCE MONITORING AND :
MEASUREMENT SYSTEM AND METHOD :

DECISION

This is in response to applicant's "Petition Under 37 CFR 1.47(a)" filed 05 September 2003.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed a petition under 37 CFR 1.47(b).

On 17 May 2002, this Office mailed a decision dismissing the 17 April 2002 petition.

On 16 December 2002, applicant filed a response to the 17 May 2002 decision.

On 30 January 2003, this Office mailed a communication in reply to applicant's 16 December 2002 response.

On 05 September 2002, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by four of the six joint inventors, each on his/her own behalf and on behalf of the nonsigning inventors.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application

oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that inventors Lim Or Sim and Yee Han Cheong refuse to sign the application papers. Although applicant has submitted evidence of Sim and Cheong's purported refusal to sign the declaration, applicant has not sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventors for signature. The affidavit of David Moore states that declarations were sent to the nonsigning inventors (see Moore's affidavit, ¶2-3) but does not state that the specification, claims, and drawings were ever presented to the nonsigning inventors.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known addresses of the nonsigning inventors.

CONCLUSION

Because applicant has failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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